



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,898	01/05/2001	Mark Miller Chesser	360115/24	5026

26371 7590 11/05/2004

FOLEY & LARDNER
777 EAST WISCONSIN AVENUE
SUITE 3800
MILWAUKEE, WI 53202-5308

EXAMINER

FLYNN, KIMBERLY D

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,898

Applicant(s)

CHESSER, MARK MILLER

Examiner

Kimberly D Flynn

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith Jr. et al (6,490,343; hereinafter Smith) in view of Zou et al (6,246,983; hereinafter Zou).

In considering claim 1 and 37-39, Smith discloses producing custom output in response to user input, the method comprising:

locating in a programmable device at least one user-specified output character associated with user input, in response to receipt of an input code representing said user input; and providing said at least one user-specified output character for use by an application program (col. 8, lines 28-32 and lines 45-54).

While Smith discloses the system substantially as claimed Smith does not specifically disclose that the user-specified output character is for use by an application program.

Nonetheless, providing user-specified output characters, linguistic phrases, or canned messages for use by an application program such as e-mail is well known as evidenced by Zou.

In similar art, Zou discloses that canned messages can be used to keep up with e-mail correspondence during business trips or vacation. Zou further discloses that an e-mail administrator or user can create custom canned messages in advance, and use them later in e-

Art Unit: 2153

mail messages (col. 8, lines 24-46). It would have been obvious to a person having ordinary skill in the art modify the system taught by Smith to include the step of providing custom outputs to an application program such as e-mail in order to allow rapid non-keystroke by keystroke communication via wireless devices. The modification would also be advantageous to users when traveling or away from the computer thus saving a great deal of time and allowing flexibility in communication. Therefore the claimed limitations would have been obvious modification to the system disclosed by Smith.

In considering claim 2, 3, and 21-22, Smith discloses further comprising receiving said input code from a web interface (col. 10, lines 3-6, and 13 -16).

In considering claim 4-5 and 23-24, Smith discloses receiving said input code from a web interface comprises receiving said input code from a wireless communications system (col. 10, lines 9-12).

In considering claim 6 and 25, Smith discloses receiving said input code from a wireless communications system comprises receiving said input code from a wireless telephone (col. 6, lines 58-61).

In considering claim 7-9, and 26-27, Zou further discloses providing said output character or linguistic phrase to an application program and performing an action based on the output (See Abstract lines 8-17).

In considering claim 11 and 28, Zou further discloses performing an action comprises inserting said linguistic phrase into a field of e-mail (col. 8, lines 24-46).

In considering claim 12-13 and 29-30, Smith discloses wherein programming said programmable device by associating at least one output character or linguistic phrases with a corresponding input code (col. 11, lines 24-33).

In considering claim 14 and 31, Smith discloses programming comprises receiving said at least one user-specified character from a user input device (col. 11, lines 5-12).

In considering claim 15-16 and 32-33, Smith discloses wherein receiving comprises receiving from a communications network programming commands for associating said at least one output character with said input code by presenting a programming interface to a user, to facilitate receiving said programming commands (col. 11, lines 19-33).

In considering claim 17 and 34, Smith discloses further comprising relating a set of input codes and corresponding output characters to a user (see fig. 3a and 3b).

In considering claim 18 and 35, Smith discloses wherein relating comprises relating sets of input codes and corresponding output characters to corresponding users (see fig. 3a and 3b).

In considering claim 19 and 36, Smith discloses wherein said processor circuit is programmed to locate a set of input codes and corresponding output characters, corresponding to a user determined from said input code (col. 12, lines 3-8 and 18-22).

In considering claim 40, Zou further discloses an apparatus for producing user defined output characters in response to input codes produced by a web-communicating input device, the system comprising a web server (fig. 1, 28) operable to establish communications with the web-communicating input device using the World Wide Web and programmed to produce at least one user specified output character for use in a field of an e-mail produced by an e-mail server (fig. 1, 23) in communication with said server, in response to receipt by said web server of an input

Art Unit: 2153

code, from said web communicating input device (see Smith col. 8, lines 28-32 and lines 45-54 and Zou col. 8, lines 24-46).

In considering claim 41, Zou discloses an e-mail system comprising:

a web server operable to establish communications with devices using the World Wide Web (fig. 1, 28);

an e-mail server operable to communicate with said web server (fig. 1, 23);

at least one of said web server and said e-mail server being programmed to produce at least one user-specified output character for use in a field of an e-mail in response to receipt of an input code from one of the devices (see Smith col. 8, lines 28-32 and lines 45-54 and Zou col. 8, lines 24-46).

In considering claims 42-43, Zou further discloses wherein the web server and e-mail server are implemented on a common computer or on separate computers (col. 3, lines 6-21, 28-35).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609.

The examiner can normally be reached on M-F 8:30 - 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2153

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly D Flynn
Examiner
Art Unit 2153

KDF


GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100